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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,988	10/31/2003	Brian M. Sager	NSL-014	8858
27652	7590	07/26/2005	EXAMINER	
JOSHUA D. ISENBERG 204 CASTRO LANE FREMONT, CA 94539			PATTERSON, MARC A	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 07/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/698,988

Applicant(s)

SAGER ET AL.

Examiner

Marc A. Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 4/27/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/11/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**WITHDRAWN REJECTIONS**

1. The 35 U.S.C. 102(b) rejection of Claims 12 – 14, 20 – 21 and 23 – 24 as being anticipated by Singh et al (WO00/78540), of record on page 3 of the previous Action, is withdrawn.
2. The 35 U.S.C. 103(a) rejection of Claims 16 – 17 as being unpatentable over Singh et al (WO00/78540), of record on page 4 of the previous Action, is withdrawn.
3. The 35 U.S.C. 103(a) rejection of Claim 15 as being unpatentable over Singh et al (WO00/78540) in view of Fibiger et al (U.S. Patent No. 6,818,163 B1), of record on page 5 of the previous Action, is withdrawn.
4. The 35 U.S.C. 103(a) rejection of Claims 18 – 19 as being unpatentable over Singh et al (WO00/78540) in view of Ogawa et al (U.S. Patent No. 5,372,888), of record on page 6 of the previous Action, is withdrawn.
5. The 35 U.S.C. 103(a) rejection of Claim 22 as being unpatentable over Singh et al (WO00/78540) in view of Brinker et al (U.S. Patent No. 6,818,163 B1), of record on page 7 of the previous Action, is withdrawn.

NEW REJECTIONS

*Specification*

6. The amendment filed April 11, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The forms of the layers which are added by the specification, including tubules and 1 and 3 dimensional connectivity, are not discussed in the original specification. The variation of the nature and amount and nature of surfactant to produce lamellar layers is also not disclosed.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 25 – 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms ‘lamellae’ in Claim 25 and ‘tubules’ in Claim 26 are not discussed in the specification.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 12 – 14, 20 – 21, 23 – 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiao (U.S. Patent No. 6,472,467 B1).

With regard to Claims 12, 14, 25 and 27, Chiao discloses a laminate film having multiple layers (multilayer sequential coating, therefore comprising multiple layers or lamellae; column 6, lines 26 – 31) wherein the adjacent layers of the film are covalently bonded to each other (the layers of the coating comprise crosslinker, therefore Chiao discloses simultaneous crosslinking of the multiple layers, and therefore discloses covalent bonding of the layers, because crosslinking occurs by chemical reaction; column 6, lines 26 – 31); the layers of the film comprise polymer (the layers are crosslinked, as discussed above) which is organic (the crosslinkable component is acrylate, therefore a non – fluorinated acrylate precursor; column 3, lines 44 – 47) and inorganic particles having a size of 5 nanometers (therefore a thickness of 5 nanometers; column 4, lines 25 – 27) and each layer is therefore an organic layer and an inorganic layer, each layer is also a barrier (column 8, lines 47 – 48) and the film is therefore an inorganic/organic hybrid nanolaminate barrier film having a plurality of layers in which layers of organic polymer material alternates with layers of inorganic material.

With regard to Claim 13, as stated above, Chiao discloses a laminate of the film, and therefore disclose a laminate which includes at least two layers of the film; Chiao therefore discloses a laminate having between 100 and 1000 layers.

With regard to Claims 20 – 21, the layers disclosed by Chiao comprise crosslinked organosilane (column 5, lines 40 – 42; column 7, lines 38 – 43) and therefore comprise layers made from polymer precursors to which a hydrophobic group comprising methyl has been added.

With regard to Claims 23 – 24, the coating disclosed by Chiao is utilized to protect the parts of an automobile (column 1, lines 15 – 18) and Chiao therefore discloses an article of manufacture, comprising a window, having the film disposed on the surface.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiao (U.S. Patent No. 6,472,467 B1) in view of Singh et al (WO 00/78540).

Chiao disclose a film as discussed above. With regard to Claims 16 – 17, Chiao fails to disclose a film which has a permeability to oxygen less than 1 cc/m<sup>2</sup>/day and a film which has a permeability to water vapor of less than 1g/m<sup>2</sup>/day. However, Singh et al teach that the permeability of oxygen and water vapor (page 64, lines 16 – 17) is dependent on the amount of

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silicate (usually small amounts of the silicate are required to achieve good high gas barrier properties; page 64, lines 25 – 29).

Therefore, one of ordinary skill in the art would have recognized the utility of varying the amount of silicate to obtain the desired permeabilities. Therefore, the permeabilities would be readily determined by through routine optimization of the amount of silicate by one having ordinary skill in the art depending on the desired use of the end product as taught by Singh et al. It therefore would be obvious for one of ordinary skill in the art to vary the amount of silicate Chiao in order to obtain the desired permeabilities, since the permeabilities would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Singh et al.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiao (U.S. Patent No. 6,472,467 B1) in view of Fibiger et al (U.S. Patent No. 6,818,163 B1).

Chiao discloses a film comprising a nanocomposite laminate comprising silicate as discussed above. Chiao fails to disclose a laminate which is substantially transparent.

Fibiger et al teach a nanocomposite (films where the layers are 100 nanometers thick; column 6, lines 16 – 19) comprising silicate (column 4, lines 10 – 11) which is substantially transparent (column 6, lines 29 – 34) for the purpose of obtaining a film that allows the passage of ultraviolet light (the film is ultraviolet transparent; column 6, lines 29 – 34). One of ordinary skill in the art would therefore have recognized the advantage of providing for the transparency of Fibiger in Chiao, which is a nanocomposite, depending on the desired passage of light of the end product.

It therefore would be obvious for one of ordinary skill in the art to provide for transparency in Chiao in order to obtaining a film that allows the passage of ultraviolet light as taught by Fibiger et al.

14. Claims 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiao (U.S. Patent No. 6,472,467 B1) in view of Ogawa et al (U. S. Patent No. 5,372,888).

Chiao disclose a film comprising barrier properties, as discussed above. With regard to Claims 18 – 19, Chiao fail to disclose a superhydrophobic layer comprising fluoroalkylsilane.

Ogawa et al teach the coating of a polymer surface (column 4, lines 23 – 27) with a fluoroalkylsilane layer (alkyl fluoride – containing chlorosilane layer), therefore a superhydrophobic layer, for the purpose of obtaining a layer that is anti – contaminating (column 3, lines 55 – 59). One of ordinary skill in the art would therefore recognize the advantage of providing for the layer of Ogawa et al in Chiao, which is a polymer and therefore comprises a polymer surface, depending on the desired anti – contamination properties of the end product.

It therefore would have been obvious for one of ordinary skill in the art to have provided for a superhydrophobic layer comprising fluoroalkylsilane in Chiao in order to obtain a layer that is anti – contaminating as taught by Ogawa et al.

15. Claims 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiao (U.S. Patent No. 6,472,467 B1) in view of Brinker et al (U.S. Patent No. 6,264,741 B1).



Chiao disclose barrier film that is a multilayer nanocomposite as discussed above. The film comprises a surfactant (page 33, lines 19 – 20). Chiao fail to disclose a surfactant comprising a Gemini surfactant and layers in the form of tubules.

Brinker et al teach the use of a Gemini surfactant (column 4, lines 45 – 46) and tubules (column 8, line 6) in a nanocomposite (column 3, lines 56 – 57) for the purpose of obtaining a nanocomposite having high capacitance (column 3, lines 51 – 55). One of ordinary skill in the art would therefore recognize the advantage of providing for the Gemini surfactant and tubules of Brinker et al in Chiao, which is a nanocomposite, depending on the desired capacitance of the end product.

It therefore would have been obvious for one of ordinary skill in the art to provide for a Gemini surfactant and tubules in Chiao in order to obtain a surface having high capacitance as taught by Brinker et al.

#### ANSWERS TO APPLICANT'S ARGUMENTS

16. Applicant's amendments and arguments regarding the 35 U.S.C. 102(b) rejection of Claims 12 – 14, 20 – 21 and 23 – 24 as being anticipated by Singh et al (WO00/78540), 35 U.S.C. 103(a) rejection of Claims 16 – 17 as being unpatentable over Singh et al (WO00/78540), 35 U.S.C. 103(a) rejection of Claim 15 as being unpatentable over Singh et al (WO00/78540) in view of Fibiger et al (U.S. Patent No. 6,818,163 B1), 35 U.S.C. 103(a) rejection of Claims 18 – 19 as being unpatentable over Singh et al (WO00/78540) in view of Ogawa et al (U.S. Patent No. 5,372,888) and 35 U.S.C. 103(a) rejection of Claim 22 as being unpatentable over Singh et al (WO00/78540) in view of Brinker et al (U.S. Patent No. 6,818,163 B1), of record in the previous

Action, have been considered and have been found to be persuasive. The rejections are therefore withdrawn. As stated above, the terms 'lamellae' in Claim 25 and 'tubules' in Claim 26 are not discussed in the specification. The amendments to those dependent claims therefore constitute new matter. However, the new matter is considered in the new rejections above.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon-Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Marc Patterson* 7/22/05  
Marc A. Patterson, PhD.  
Examiner  
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